No. 472.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE

NINTH CIRCUIT

Herman Cramer,

Plaintiff in Error,

VS

The Singer Manufacturing Co.,
(A Corporation,)

Defendant in Error.

Brief for Defendant in Error.

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HERMAN CRAMER, *Plaintiff in Error,* vs. THE SINGER MANUFACTURING COMPANY (A CORPORATION), *Defendant in Error.*	No. 472.

Brief for Defendant in Error.

The Plaintiff's Case is Disposed of by the Judgment in the Fry Case.

Plaintiff's counsel asserts that the judgment in *Cramer* vs. *Fry* is not *res adjudicata* as to this case, because the Singer Company was not a party to that action, nor in privity with any party thereto. A very large number of adjudged patent cases are not in accord with plaintiff's counsel in his views upon this subject, as those views are expressed in his brief. The judgment of dismissal as to the Singer Company in the Fry case was made and entered on December 19, 1893 (record, p. 60). This judgment was rendered upon the ground that the Court had no jurisdiction over the *person* of The Singer Company. There was never any question that the Court had jurisdiction over the subject-matter of the action. The judgment of dismissal left the Singer Company in just exactly the position it would have been in if it had never been made a party to the action in the first place. The

company was entirely out of the action as much as if it had never been sued, and might thereafter participate in the trial of the action or not, as it chose. That trial did not take place until April, 1895 (record, p. 69), more than a year after the dismissal as to the Singer Company. Fry, the defendant, was merely the agent of the Singer Company. His defense was entirely made by the Singer Company. That company furnished all the testimony, both oral and documentary, provided the models and exhibits for the trial, retained and paid all the attorneys for the defense, was present and controlled the defense during the trial by its own attorneys, and in all respects assumed the responsibility and burden of the defense, both pecuniary and otherwise (Record, pp. 70–76).

The alleged infringement by Fry, in the old case, was the sale by Fry, as the Singer Company's agent, of sewing machines containing treadles made according to the specifications and drawings of the Diehl patent, which belonged to the Singer Company. *The Diehl treadles were held to not infringe on the Cramer patent.*

In the case at bar, the alleged infringement by the Singer Company was the manufacture and sale of the same identical Diehl treadles which were adjudged in the Fry case not to infringe the Cramer patent. In the first case it was the sale by the agent, and in the second case it is the sale by the principal, and the thing shown to have been sold is the *same in both cases.* The Singer Company defended its agent, in the first case, for having done the very same thing which in this case it is defending itself for having done.

These Facts Bring This Case Directly Within the Ruling of a Large Number of Adjudged Cases.

" It is a requirement of public policy and of private
" peace, that each particular litigation shall duly come to
" an end, and that when once ended, it shall not be re-
" vived. The law therefore properly requires that things
" adjudicated shall not again be drawn in question be-
" tween the same parties, or between any persons whose
" connection with the adjudication is such that they
" ought not to be permitted to gainsay its result."

Walker on Patents, 3d Ed., Sec. 468.

" Conclusive effect of judgments respecting the same
" cause of action and between the same parties rests
" upon the just and expedient axiom, that it is for the
" interest of the community that a limit should be op-
" posed to the continuance of litigation, and that the
" same cause of action should not be brought twice to a
" final determination.

" Parties in that connection include all who are directly
" interested in the subject-matter, and who had a right
" to make defense, control the proceedings, examine and
" cross-examine witnesses, and appeal from the judg-
" ment."

Robbins vs. *Chicago City*, 4 Wall., 672.
Lovejoy vs. *Murray*, 3 Wall., 18.

" The estoppel precludes parties and privies from
" contending to the contrary of that point or matter of

"fact, which, having been once distinctly put in issue
"by them, or by those to whom they are privy in estate
"or law, has been, on such issue joined, solemnly found
"against them."

Cromwell vs. *County of Sac*, 94 U. S., 353.

"In *Cromwell* vs. *County of Sac*, 94 U. S., 351, we
"considered at much length the operation of a judg-
"ment as a bar against the prosecution of a second ac-
"tion upon the same demand, and as an estoppel upon
"the question litigated and determined in another action
"between the same parties upon a different demand,
"and we held, following in this respect a long series
"of decisions, that in the former case the judgment, if
"rendered upon the merits, is an absolute bar to a
"subsequent action, a finality to the demand in contro-
"versy, concluding parties and those in privity with
"them; and that in the latter case, that is, where the
"second action between the same parties is upon a dif-
"ferent demand, the judgment in the first action operates
"as an estoppel as to those matters in issue, or points
"controverted, upon the determination of which the
"finding or verdict was rendered."

Wilson's Executor vs. *Deen*, 121 U. S., 532.

"Notwithstanding some expressions in *Cromwell* vs.
"*Sac Co.*, and in the various decisions to which it has
"led, the rule of law has never been disturbed that
"where, in a prior suit, it appears of record that any
"particular question has been actually adjudicated, the

" prior judgment is to that extent conclusive in any sub-
" sequent suit between the same parties or their privies,
" relating to an instrument which forms the basis of liti-
" gation in each."

Empire State Nail Co. vs. *American Co.*, 74 Fed. Rep., 866.

" The object in establishing judicial tribunals is that
" controversies between parties, which may be the sub-
" ject of litigation, shall be finally determined. The
" peace and order of society demand that matters dis-
" tinctly put in issue and determined by a court of com-
" petent jurisdiction as to parties and subject-matter,
" shall not be retried between the same parties in any
" subsequent suit in any court."

Johnson Co. vs. *Wharton*, 152 U. S., 257.

It has been ruled expressly that a contribution, even, to a fund for defending a suit on letters patent renders the contributors privies to the decrees therein. In *Miller* vs. *The Tobacco Co.*, 7 Fed. Rep., 93, a case in which the facts in this regard were the same as the facts of the present case, the Court, Judges McCrary and Treat, say :

" I think that a party who contributes money for the
" purpose of employing counsel, and carrying on a liti-
" gation, under a contract with a party to the record,
" must of necessity be held to have the right to take
" such action in the case as will protect his own interest
" in it. As, for example, suppose there is a case, which

" is understood to be a test case, involving the validity
" of a patent, or anything else, against a particular indi-
" vidual, but involving a subject-matter concerning which
" a large number of other persons are equally interested
" with the particular defendant in that case, and suppose
" all the parties who are interested, or a number of them,
" come together, enter into a contract that they will raise
" a fund to carry on that litigation, that they will unite
" for the purpose of employing counsel, and combine to
" carry it on in the name of the party to the record, it
" seems to me that the persons who, under such a con-
" tract as that, actually contribute money for the purpose
" of carrying on a suit, are authorized to go into that
" court and use the name of the party to the record in
" making such motions and taking such steps as are
" necessary for the protection of their particular interest
" in it."

Where the present defendant was the real though not the nominal defendant in a former suit, wherein the present complainant was the then complainant, the findings are conclusive in the present suit.

> *The U. S. etc. Felting Co.* vs. *Asbestos Felting Co.*, 5 B. & A., 622; 4 Fed. Rep., 816.

" The defendants in the first suit were the agents of
" the defendants in this suit. Through these agents the
" present defendants resisted Claflin & Co.'s claim of
" ownership in the state court. Extrinsic evidence is
" admissible to prove that a real party in a suit was not

"a party to the record, but that he prosecuted or de-
"fended the suit in the name of a nominal party; and
"whenever this is made to appear, the real party is
"concluded by the judgment as effectually as if he had
"been a party to the record."

Claflin vs. *Fletcher*, 7 Fed Rep., 852.

The claim sued upon in *Hayes* vs. *Dayton* had been formerly disposed of by a court of concurrent jurisdiction in *Hayes* vs. *Seton*. Referring to the judgment of the Court in the earlier case, Judge Coxe said in the latter case :

"So long as this decision is undisturbed by the only
"tribunal which has a right to review it, it must remain
"the law governing the case. The spectacle of one court
"overruling or reversing another court of co-ordinate ju-
"risdiction, in the same circuit, would certainly be an
"anomalous one. It would be without precedent and
"would lead to inextricable confusion."

Hayes vs. *Dayton*, 20 Fed., 691.

The question of the validity of a patent is *res adjudicata*, where it has been adjudicated by another judge of the same circuit, and the parties to the two actions are, in contemplation of law, the same, and the records are substantially identical.

Heysinger vs. *Rouss*, 40 Fed. Rep. 584.

A judgment or decree of a court of competent juristion between two parties, as to the validity of a patent,

is conclusive in any other suit between them or their privies of every matter that was decided therein, and that was essential to the decision made.

> *David Bradley Mfg Co.* vs. *Eagle Co.*, 57 Fed. Rep., 984, 990; 58 Fed. Rep., 721.
>
> *Eagle Co.* vs. *Moline Co.*, 50 Fed. Rep., 195.

In *Theller* vs. *Hershey*, No. 12,139, in which an opinion was filed in the Circuit Court here on the 29th of September last, it was alleged in the bill that the respondent, Hershey, had participated in the trial of a former action by the same complainant against a different defendant; that the acts of infringement charged in the two cases were identical; that the defendant, Theller, had contributed to the defense of the former action under an agreement with Ross, the defendant therein, to aid in the defense; that the respondent, Theller, had employed attorneys and an expert for the defense in the former action, and had built or caused to be built a model for defendant's use in said action; that there was a verdict against the defendant in said former action. Complainant contended that the respondent Hershey was estopped to deny infringement by the judgment in the former case against Ross. A demurrer was interposed to the averments concerning the former action of *Theller* vs. *Ross*. Judge Hawley, in overruling the demurrer, held that the averments of the bill were suffi- to show that the respondent was privy to the former action, and in the course of his opinion said :

" It is not necessary for the complainant to allege in
" direct terms that the respondent had such control over
" the former action as to be bound by the proceedings
" had therein; but he is required to state such facts as
" will enable the Court to determine whether, if true, he
" is so bound. I am of opinion that the facts stated in the
" complaint are sufficient. Ordinarily it is for the Court
" in the trial of a case to determine who are parties and
" privies. Parties include not only those whose names
" appear upon the record, but all others who participate
" in the litigation by employing counsel, or by contribu-
" ting toward the expenses thereof, or who, in any man-
" ner, have such control thereof as to be entitled to di-
" rect the course of proceedings therein."

The Judgment in the Fry Case was Controlling, Regardless of Identity or Privity of Parties.

It was solemnly adjudged by Judge McKenna in the Fry case, 68 Fed. Rep., 201, that a machine made according to the specifications of the Diehl patent No. 306,469 did not infringe the Cramer patent No. 271,426. This determination was made by the Court after an exhaustive inquiry into the state of the art and into the limitations which Cramer had imposed upon himself in the Patent Office, as disclosed by the file wrapper and contents of his patent. From the judgment in the Fry case Cramer did not appeal.

The question of infringement in the case at bar was

exactly identical with the same question in the Fry case, viz.: "Does a sewing machine treadle constructed according to the specifications and claims of the Diehl patent infringe the Cramer patent?" How many times may Cramer have that question tried in the Circuit Court of the Northern District of California? Is it not the law that when, upon a given state of facts, a Circuit Court has judicially determined the status of a patent, with relation to those facts, then that judicial determination will afterwards be followed whenever the status of the patent with relation to the same facts is in question, until there be a different determination upon appeal? An adjudication that a patent is invalid is in the nature of a judgment *in rem.* It fixes the status of the patent as to everybody. The same is true of an adjudication by which the claims of a patent are construed in the light of a given state of facts. When the Circuit Court of this district said to Cramer: "It is "not an infringement of your patent for anyone to sell "sewing machines containing treadles made under and "according to the Diehl patent," and rendered judgment accordingly, that particular question was settled, so far as the Circuit Court was concerned, unless its judgment was reversed by a higher court. This is the rule announced in scores of well-considered cases, as between the courts of different circuits. By how much greater reason should it prevail, when the issue passed upon by one judge of a Circuit Court comes before another judge of *the same court* upon *the same state of facts.*

It was perfectly proper for Judge Beatty to follow Judge McKenna, as to any issue upon which the latter had passed, and with reference to precisely the same state of facts; and it was proper upon considerations of comity, whether there was any privity between the Singer Company and Fry or not. Cramer having obtained the judgment of the Circuit Court upon the question of infringement of his patent by the Diehl machine, and having declined to appeal from the judgment, has had all he is entitled to ask from the Circuit Court upon the same question, with reference to the same state of facts, until the judgment has been reversed by a higher court. And he has made no effort to have the judgment in the Fry case reviewed by this Court, so far as the record shows.

"Although we would by no means confine our acquiescence in the decisions of our brother judges to "cases where the particular patent has been adjudged "to be valid, or that a particular device infringes upon "it, still we think that eminently beyond other cases is "the rule applicable to them. The right of the complainant is a special franchise granted by the political power. "A special organism is created for the purpose of ascertaining his right to the grant. When issued, the several federal courts are authorized to review the rectitude of this action, and from their determination an "appeal lies to the court of last resort. It is an indivisible system for ascertaining the rightfulness and the "limits of the patent, and when, in any co-ordinate department of it, judgment has been pronounced, that

"duty should be deemed performed until reversed by "the appellate tribunal. It would present an unseemly "spectacle, for the same governmental grant to receive "half a dozen different constructions in as many co-or- "dinate courts, all authorized to define it and inform the "citizens what it means, and all having the force of law "contemporaneously under the same government We "cannot speak with great certainty, but do affirm with "much confidence that the expenses paid in our country "for patent litigations are rapidly approximating the en- "tire sum demanded for royalties. Until some special "tribunal is instituted for the determination of these "questions, and some general mode of reviewing these "public grants, which shall test definitely the rightful- "ness of the grants, it will result in a large saving of "money to the great masses of our citizens who are us- "ing these improvements, to let them and their advisers "of the profession understand that a fair and full exam- "ination in one court, followed by a judgment, will, in "the other co-ordinate tribunals, be acquiesced in as "law, if there is no appeal and reversal."

Goodyear Co. vs. *Willis*, 1 B. & A., 573.

An adjudication by a Circuit Court of Appeals sustaining a patent, and construing its claims, will be followed by a Circuit Court in another circuit, unless some new evidence is presented, of such a character as might fairly be supposed to be calculated to induce a different decision if it had been produced before that Court.

Cons. Car Heating Co. vs. *Gold Car Heating Co.*, 87 Fed., 996.

"Judgments against the patent are, for obvious rea-
"sons, of higher value and a wider influence, since a
'patent invalid upon any ground is invalid against all
"the world, and therefore any decision declaring it void,
"though in a different tribunal and between other
"parties, affords a presumption of its invalidity which
"the plaintiff can with difficulty overcome.

3 Robinson on Patents, Sec. 1184.
Meyer vs. *Goodyear Co.*, 11 Fed. Rep., 891.
McCloskey vs. *Hamill*, 15 Fed. Rep., 750.
Green vs. *City of Lynn*, 55 Fed. Rep., 519.
Celluloid Co. vs. *Zylonite Co.*, 27 Fed. Rep., 295.
Acme Harvester Co vs. *Frobes*, 69 Fed Rep., 152.

Where in a former suit the claim of the patent sued upon had been restricted to a special construction, in was held in a later suit between the plaintiff of the former suit and a new defendant that no broader construction to the patent could be given in the second suit than had been adjudged in the former suit, and that the question of infringement alone remained to be considered. As the mechanism alleged to infringe in the later suit was found to be identical with that which had been alleged to infringe in the former suit, a decree for the defendant was rendered in the later suit.

Field vs. *Ireland*, 19 Fed. Rep., 835.

A proper regard for uniformity of decision requires that where one Circuit Court has, after a full discussion of the evidence, sustained a patent, another Circuit Court should, unless plain mistake be shown, follow such decision in a suit upon the same patent in which the same evidence is relied on.

Hammerschlag vs. *Garrett*, 9 Fed. Rep., 43.

"Upon general questions of law we listen to the "opinions of our brother judges with deference, and "with a desire to conform to them if we can conscien-"tiously do so, but we do not treat them as conclusive. "In patent causes, however, where the same issue has "been passed upon by the Circuit Court sitting in an-"other district, it is only in case of a clear mistake of "law or fact, of newly-discovered testimony, or upon "some question not considered by such court, that we "feel at liberty to review its findings. A division of "opinion upon the same issue might give rise to litiga-"tion in a dozen different districts, to conflicting decrees, "and to interminable contests between rival patentees. "In case the defeated party is dissatisfied with the first "decision, it is his right to resort to the appellate court, "where a final decision can be obtained, which all "inferior courts are bound to respect."

Searls vs. *Worden*, 11 Fed. Rep., 502.

The decision of a United States Circuit Court, where the subject matter, the pleadings, and the evidence are alike, will be followed by other Circuit Courts, especially when the validity of the patent is involved.

Worswick Co. vs. *City of Philadelphia*, 30 Fed. Rep., 625.

" The defendant admits the force of the doctrine in-
" voked by the complainant, but insists that the parties
" are different from those in the case relied upon
" to sustain complainant's contention, the issues
" are different, and the evidence upon those is-
" sues is different, and therefore he claims to be
" entitled to have the validity of the patent passed
" upon again by this court. The fact that the present
" defendant was not a party to the cause decided by
" Judge Butler is immaterial in considering the control-
" ling effect of that opinion. The main issue in that case,
" as in this, was the validity of the letters patent. That
" was the question of law presented to the learned
" judge for decision, and it is as to that same issue as
" now made that the doctrine of *stare decisis* is invoked.
" The fact that the defendant in the present case was
" not in anywise personally interested in the former case
" cannot be regarded as lessening in any degree the
" binding effect of a solemn decision made in that cause.
" What was decided was a question of law arising upon
" these very letters patent. Such decision becomes a
" precedent, to be followed in all cases in which the
" same legal question arising from the same letters
" patent presents itself for consideration, and an au-
" thority implicitly to govern, unless it clearly appears
" that the principles which underlie it have been grossly
" misunderstood or misapplied."

Zinsser vs. *Krueger*, 45 Fed. Rep., 574.

"A proper regard for the interests of suitors requires "that the decisions shall be given controlling effect. "The importance of uniformity in the law, as adminis- "tered in the several circuits, is too great to be disre- "garded, even where the judges may differ in opinion. "Conflicting decisions on the same patent would be an "intolerable evil."

Enterprise Co. vs. *Deisler*, 46 Fed. Rep., 855.

"The importance of uniformity of decisions in courts "of co-ordinate jurisdiction and authority is such that "even grave doubt respecting the soundness of a par- "ticular decision is not a sufficient warrant for disre- "garding it. The proper remedy, where such doubt "exists, is by appeal."

Macbeth vs. *Gillinder*, 54 Fed. Rep., 170.

"This Court will not examine anew the question "which has thus been adjudicated, but will accept the "decisions referred to as determinate of the effect of "the evidence upon which they were based. *Wana- "maker* vs. *Manufacturing Co.*, 3 C. C. A. 672, 53 "Fed., 791. If the rule here avderted to were one of "'comity' merely, it would, I think, be impossible to "justify its derogation from the right of suitors to the "veritable judgment of the tribunal to which any par- "ticular case is confided for decision. Upon general "questions of law, the views of courts of co-ordinate

" jurisdiction are always regarded with respectful con-
" sideration, but never as controlling. In patent causes,
" however, conclusive effect is accorded by each of the
" Circuit Courts of the United States to a prior judg-
" ment of any other of them, wherever the patent, the
" question, and the evidence are the same in both suits,
" not on the ground of comity alone, but with the prac-
" tical and salutary object of avoiding repeated litiga-
" tion and conflicting decrees in the courts of the several
" districts upon matters which, having been once passed
" upon by a court of first instance, ought to be referred
" to a court of appeal for authoritative determination."

> *Office Specialty Mfg. Co.* vs. *Winternight etc. Mfg. Co.*, 67 Fed. Rep., 928.
>
> *National Register Co.* vs. *American Register Co.*, 47 Fed. Rep., 217.
>
> *Wanamaker* vs. *Enterprise Co.*, 53 Fed. Rep., 791.

"It is a principle of general jurisprudence that courts
" of concurrent or co-ordinate jurisdiction will follow the
" deliberate decisions of each other, in order to prevent
" unseemly conflicts and to preserve uniformity of de-
" cision and harmony of action. This principle is no-
" where more firmly established or more implicitly fol-
" lowed than in the Circuit Courts of the United States.
" A deliberate decision of a question of law by one of
" these courts is generally treated as a controlling pre-
" cedent in every federal Circuit Court in the Union,
" until it is reversed or modified by an appellate court."

Shreve vs. *Cheesman*, 69 Fed. Rep., 790.

"The rule is well established that where a court of
"co-ordinate jurisdiction has, on full hearing, declared
"a patent invalid, this Court will not reconsider the
"case unless there was in the former adjudication man-
"ifest error in law or manifest mistake in fact."

"A ruling declaring the validity of a patent is not en-
"titled to the same consideration as a ruling declaring
"the patent invalid."

Acme Harvester Co. vs. *Frobes*, 69 Fed. Rep., 149, 152.

Judge McKenna's Opinion in Cramer vs. Fry.

The opinion of Judge McKenna in *Cramer* vs. *Fry* was not submitted to the jury nor read to the jury.

In re Westerfield, 96 Cal., 113, 116.

This case is not one in which there could have been injury caused to plaintiff by reason of prejudice or misapprehension created in the minds of the jury by the admission of incompetent or irrelevant testimony. The opinion was not mentioned until after Judge Beatty had announced his decision overruling the objection to the judgment roll, which, of course, as the Court said (record, p. 85), virtually amounted to a determination of the case. Prior to that, Judge Beatty had said (record, p. 77) that he had "looked

over the old case," and thought the patents were the same as those introduced in the present case, and that the same evidence was introduced in both cases. "I "could not well determine that *without going over the whole evidence*," said the Court. The Court also said, referring to the old case: "I made up my mind that the "cases are the same before I came into Court. *I exam-* "*ined all those papers*." That is, the Court had examined the case, including the opinion of Judge McKenna, before that opinion was mentioned.

The judgment roll from the Fry case had already been introduced, and was sufficient to prove what issues were raised by the pleadings, etc., and that the judgment had gone against the plaintiff. To ascertain why that judgment went against the plaintiff, it was not only proper but necessary to read the reasons given by Judge McKenna as contained in his opinion. The question whether Judge McKenna had held in the Fry case that machines made under the Diehl patent did not infringe the Cramer patent, could certainly be ascertained by referring to the opinion itself. Judge Beatty's decision in this case was not founded upon Judge McKenna's opinion alone. That opinion was not introduced to prove which way the judgment went in the Fry case, but was merely consulted by Judge Beatty after he had examined the papers and exhibits in the case, for the purpose of ascertaining Judge McKenna's reasons for his decision. The cases cited on page 11 of plaintiff's brief are only upon the point that where special findings of fact by the lower Court are required to be pro-

duced on appeal in the upper Court, the *opinion* of the lower Court cannot be given the force and effect of special findings. The decisions cited by counsel do not have any bearing upon the case at bar.

On page 11 of his brief, and for several pages following, the plaintiff in error states, as a proposition for argument, that "no case ever decided that a statement of "facts in an opinion of a court or judge is legal evidence "of the facts stated," that "the opinion of the court be- "low upon direct appeal in the same case, is neither "competent nor sufficient proof of the evidence given or "of the facts decided in such case on direct attack, nor "can it be proved in a subsequent action." Several decisions of the Supreme Court are cited in the brief to establish this proposition.

There is, however, no such point or proposition involved in the case now before the court. Plaintiff in error states the proposition as a basis for showing that the Court erred in admitting in evidence the opinion of Judge McKenna, rendered in the case of *Cramer* vs. *Fry*, and reported in 68 Fed. Rep., beginning on page 201.

This opinion of Judge McKenna was in writing and filed in the case. It was actually the decision of the Court, and was something more than a mere opinion. It was not offered in evidence as proof of any facts which were recited in it. It was offered solely for the purpose of showing *exactly what was adjudicated in that former trial.* In our amended answer in this case

(record, pp. 43-44), we have set up the adjudication of the Court in the case of *Cramer* vs. *Fry* and have pleaded it as a bar to this action. We have there set up that the infringements charged consisted solely of the making and selling of treadles and treadle mechanism constructed according to the specifications and claims of the Diehl letters patent No. 306,469. We further set up that it was adjudicated in said action that said machines were not any infringement of the plaintiff's patent. The particular question involved here is whether or not the issue was tried and adjudicated in that case, as to whether the particular machine which the defendant is now charged with making and selling constituted an infringement of the particular patent sued on or not. The question is not whether any facts stated in the said opinion and decision of the court existed or not, but the question is what was decided in that case. One other point besides the issue of infringement was decided in that case, which was that the defendant Fry would be liable as an infringer, providing that the particular machines (which machines were those made in accordance with the Diehl patent) were infringements of the plaintiff's patent.

A drawing of the Diehl machines is shown in 68 Fed. Rep. on page 204.

In *Russell* vs. *Place*, 94 U. S. 606, the Court (on page 608) says:

" It is undoubtedly settled law that a judgment of a
" Court of competent jurisdiction, upon a question

"directly involved in one suit, is conclusive as to that "question in another suit between the same parties. "But to this operation of the judgment it must appear, "either upon the face of the record or be shown by ex- "trinsic evidence, that the precise question was raised "and determined in the former suit." The case also holds that extrinsic evidence, consistent with the record, may be resorted to to show that the verdict and judgment necessarily involved the consideration and determination of the matter.

What we were endeavoring to prove was not any particular facts which would tend to prove whether there was or was not an infringement, or anything of that kind; we were only proving what had been adjudicated in the former case. Not one of the authorities cited by the plaintiff in error bears upon this point at all; not one of them pretends to assert that a written opinion filed as a part of the record in the case is not competent evidence to show what issue was decided in the case. The cases cited go no further than to show that upon a second trial, either between the same or other parties, of the same or similar issues, neither party can substitute for proper proof of the facts what a Court had formerly decided to be the facts. There is a wide difference between proving the pertinent facts upon which an issue is to be decided and proving that the same issue had already been decided and adjudicated. The facts of a case are one thing, while the issue that is tried and adjudicated, and which may or may not rest upon those facts, is another thing.

Now, the question in this case is, not what Judge McKenna decided to be the facts in the Fry case, but what *issue* in that case was decided and adjudicated. Did he or did he not decide and adjudge that the particular kind of machines which the defendant has been making and selling were not an infringement of the plaintiff's patent? If he did, then our plea of the former adjudication is good. After going through the brief of the plaintiff in error, we fail to find a single shadow of authority for deciding or even intimating that the written opinion of a Court, filed in a case as a part of the record is not competent evidence tending to prove the exact issue which the Court decided. In fact, we do not find counsel even giving their personal indorsement to such a proposition. The authorities are the other way, and hold that the opinion of the Court may be introduced in evidence to prove what was decided in the former adjudication.

In Freeman on Judgments, Sec. 273, the author says: "It may always be shown by evidence, *aliunde*, that any "matter which the issue was broad enough to cover "arose and was determined in the prior suit. The "record may be first put in evidence, and then it may "be followed by such parol evidence as may be neces- "sary to give it proper effect. If the record in an "action of ejectment does not show on what grounds "the plaintiff or defendant recovered, it may be ex- "plained by showing what title was established or set "up in the action. And for the purpose of ascertain-

" ing what was determined in a former action, *the opin-* " *ion of the Court* and the briefs of counsel may be " considered."

To establish this statement Freeman makes many citations.

In *New Orleans M. & C. R. Co.* vs. *City of New Orleans*, 14 Fed. Rep., 373, the rule is stated in the syllabus as follows:

" In determining what has been adjudged courts will " regard the decree, and in case of ambiguity, but not " otherwise, *be governed by an accompanying opinion.*" See also the last clause, page 376 of the decision.

Lawrence vs. *Stearns*, 79 Fed. Rep., 878, also holds that in the State of Michigan "the opinion of the Su- " preme Court of that State is competent, and the best " evidence of the grounds of the adjudication in any " case upon the questions litigated and determined " therein."

On page 883 of this case the Court says:

" It is insisted that the opinion of the Court is nothing " but hearsay; that it is no part of the judgment, nor, " indeed any part of the record. And it is insisted that " if the question as to the grounds of the decree may be " gone into by proof outside of the decree itself, that " witnesses should be called, and the matter proved in " the ordinary way. This does not appear to me to be " a reasonable contention. In fact, I think *there can be*

"*no higher or better evidence than the written opinion*
"*of the Court itself* upon which the decree is framed."

On the next page, 884, are several citations to sustain the rule that the opinion of the Court is competent evidence to show what was decided.

In *Stearns* vs. *Lawrence*, 83 Fed. Rep., 738, the decision was made by the Circuit Court of Appeals of the Sixth Circuit. It is therefore a very high authority. Commencing on page 742, the decision discusses the question whether the Court may not look to the opinion of the Supreme Court of Michigan for the purpose of determining what particular issues were decided by that Court. On this discussion the Court cites and expatiates upon other decisions bearing upon the same point, including decisions of the United States Supreme Court. This decision of the Court of Appeals of the Sixth Circuit, with the numerous and high authorities cited in it upon this exact point, we think ought to be conclusive. The decision cites *Corcoran* vs. *Canal Co.*, 94 U. S., 741; also, *Last Chance Min. Co* vs. *Tyler Min. Co.*, 157 U. S., 690; also, *Satterlee* vs. *Matthewson*, 2 Pet. 410. We think that the authorities cited by us ought to settle the question as to the admissibility of Judge McKenna's opinion for the purpose of showing the particular issue that was adjudicated in the case of *Cramer* vs. *Fry*, particularly as counsel for the plaintiff in error have so far been unable to produce, or at least have not produced, a particle of authority to the contrary.

Outside of the said opinion of Judge McKenna we find enough in the former judgment roll of the suit of *Cramer* vs. *Fry* to justify the Circuit Court in holding that there was an adjudication, in the former case, that the machines which were sold by Willis B. Fry did not constitute any infringement of the plaintiff's patent. On pages 69 and 70 of the record there is quoted the judgment in the said case of *Cramer* vs. *Fry*, a part of which is as follows:

"After hearing the evidence and considering the motion " of defendant's counsel that the jury find a verdict for " defendant, it was ordered by the Court that said " motion be granted, and thereupon the jury was in- " structed to return a verdict for the defendant *on the* " *ground of non infringement*, which was done as fol- " lows:" etc., etc.

Here, therefore, it appears directly in the judgment roll itself that there was an adjudication that the machines sold by Fry did not constitute any infringement of the plaintiff's patent.

As shown by the latter part of page 77 of the record, Mr. Wheaton stated the proposition clearly that it was necessary for the defendant to show that the same question was litigated and determined by the judgment in that case which was being litigated in this, and offered to show by proof that the *same identical machine* which is charged to be an infringement here, and which was a standard made under the Diehl patent, was the same

identical machine which was introduced as the infringing machine in the case of *Cramer* vs. *Fry*. Notwithstanding Mr. Wheaton's explicit statement of what he intended to prove, the plaintiff's attorney objected to the evidence, and secured a ruling by which it was excluded.

Plaintiff Cannot Take Advantage of an Alleged Error Which Was Caused by His Own Counsel.

The plaintiff insists that the evidence introduced at the trial fails to show that the case at bar was the same as that of *Cramer* vs. *Fry* (brief, p. 16). At the bottom of page 18 of his brief, plaintiff says: "It was incumbent, "therefore, upon the defendant to show the identity of "the present defendant's machine with the alleged in-"fringing machine in the case of *Cramer* vs. *Fry*," etc. An examination of the record, pages 76–79, shows that counsel for the defendant offered to prove that the *very identical machine* which was charged to infringe in this case, was *the identical machine* which was charged to infringe in the Fry case, and that they offered to prove this by showing that the machine introduced as an exhibit of the defendant's machine in this case was the *very same machine* which was introduced as an exhibit of the defendant's machine in the Fry case. This testimony was strenuously objected to by Mr. Miller, and was excluded by the Court. In other words, plaintiff's counsel now seeks to avail himself of an alleged error of the

Court below which he himself was instrumental in bringing about. If the testimony which was sought to be obtained from Mr. Fry (record, page 76) had been admitted, it would have been shown that Exhibit G, which was introduced as a representation of the defendant's machine, was,as explicitly stated by Mr. Wheaton on page 77, the *very same identical machine* which had been introduced in the Fry case to represent the defendant's machine. In other words, the machine charged to infringe in these two cases was exactly the same. This is the very kind of testimony which plaintiff's counsel complains ought to have been in this case, in order to sustain the finding of the Court that the Fry case and this case are the same, and yet this is the *very testimony* the introduction of which counsel vigorously opposed and succeeded in excluding. In other words, having succeeded in leading the Court into a position which he now claims to have been erroneus, the counsel seeks to take advantage of it. This course on the part of counsel is not tolerated in any Court.

"If evidence is erroneously excluded upon appellant's "objection, he must abide the consequences; he cannot, "therefore, ask that the judgment be reversed because "there is no evidence to support it, if the excluded evi-"dence was clearly sufficient to justify it."

2 Encyc. of Pldg. & Prac. 523.

"It is a principle of appellate procedure that an error, "to be available on appeal, must have occurred without "the express or implied consent of the appellant."

2 Encyc. of Pldg. & Prac. 516.

A party will not be heard to complain of errors which he himself has induced the trial court to commit.

Walton vs. *Ry. Co.*, 56 Fed. Rep., 1036.
Little Rock Co. vs. *Moseley*, 56 Fed. Rep., 1010.
Clemson vs. *State Bank*, 2 Ill., 45.
Borden vs. *Croak*, 131 Ill., 68; 19 Am. St. Rep., 23.
Kincaid vs. *Higgins*, 4 Ky., 396.
Blakey vs. *Blakey*, 26 Ky., 674.
Mudget vs. *Kent*, 18 Maine, 349.
Loomis vs. *Ry. Co.*, 17 Mo. Appeals, 340.
Price vs. *Town of Breckenridge*, 92 Mo. 378.
Atkinson vs. *Taylor*, 34 Mo. Appeals, 442.

It would be grossly unfair treatment of trial courts if attorneys could lead the courts into erroneous rulings, and then obtain judgments of reversal in higher courts by reason of the very rulings which they themselves were instrumental in bringing about.

For all the purposes of this appeal it ought to be considered that it was proven by Mr. Fry at the trial that the machine which was charged to infringe in this case was exactly identical with the machine which was charged to infringe in the Fry case (record page 76-77). Such would have been Mr. Fry's testimony. Mr. Wheaton's offer on page 77 shows what the testimony would have been. The absence of this testimony is due to the strenuous objection of plaintiff's attorney, and

the absence of this testimony is now urged to sustain plaintiff's contention, commencing at page 16 of his brief, that the identity of the alleged infringing machine in this case with that in the Fry case is not shown by the evidence. As the courts do not allow this practice, this case should be heard, it seems to us, as if the excluded testimony of Mr. Fry were in the record as it was stated by Mr. Wheaton.

The Judgment Roll of the Fry Case Was Properly Admitted.

Plaintiff's sixth assignment of error relates to the introduction of the judgment roll from the Fry case in evidence.

The judgment roll was admissible in evidence under the pleadings. The judgment against the plaintiff in *Cramer* vs. *Fry* having been pleaded in defendant's amended answer in this case (record, pp. 20 and 24), the testimony was relevant and material. The *effect* of the judgment roll as evidence was a matter for subsequent consideration. Its *admissibility* was one thing; its *weight* or *sufficiency* was another thing.

On pages 22 to 27 of plaintiff's brief is a lot of very learned criticism upon the defendant's answer as a pleading. It will be seen upon reference to the record (p. 25) that there was a demurrer to the answer, and by reference to the ruling on the demurrer (record, p. 27) it will be seen that there was also a motion to strike out

parts of the answer. The portion of the original answer (record, p. 8) to which the plaintiff demurred, commenced at the middle of page 18 and extended to the last paragraph on page 20. The motion to strike out affected that portion of the answer commencing with the last paragraph on page 20 and extending through the paragraph ending at the top of page 24. When it appeared very certain to plaintiff's counsel that his motion to strike out could not prevail, that motion was withdrawn, as appears by the order on page 27 of the record. The defendant consented to amend its answer, as also appears by said order, and an amended answer was afterwards filed. The amended answer appears in the record commencing at page 28, and upon examination it will be seen that *all those portions of the original answer against which the demurrer and motion to strike out were directed were retained in the amended answer*, the only change being the addition of the paragraph commencing at the bottom of page 43 of the record and extending into page 44. Thus these very portions of the answer against which the counsel's learned disquisition is directed were retained in the lower court, notwithstanding his demurrer and motion to strike out. In other words, under the pleadings, as finally amended, the existence of the judgment in *Cramer* vs. *Fry* was an issue in the case, and of course the judgment roll was relevant and material to that issue and was therefore admissible in evidence.

Plaintiff's counsel devotes a few pages of his brief

(28-33) to the judgment in favor of the Singer Company in *Cramer* vs. *Fry*, as (1) made by its terms without prejudice to another action ; and (2) as being erroneously entered as a separate judgment in favor of the Singer Company, while another judgment was afterwards entered in the same case in favor of Fry. The reasoning of counsel upon the latter point does not appear to have the sanction of authority, so far as the argument of plaintiff's brief discloses.

Of course, the judgment in favor of the Singer Company in the Fry case was upon its face without prejudice to another action. All that was meant by that, however, was that the particular judgment in question, in which the question of jurisdiction only was involved, was not conclusive as to other questions, for instance the question of infringement. In other words, the issue of infringement in the Fry case, *i. e.*, whether the Diehl treadle infringed the Cramer patent, was not disposed of by the judgment in favor of the Singer Company. But it was afterwards disposed of by the judgment in favor of Fry

Plaintiff's counsel seems to deem it extremely desirable to have the two judgments of the Fry case considered as one. This, no doubt, to put us into the position of pleading, in estoppel, upon the issue of infringement, a judgment which upon its face was not an adjudication upon that queston. Argument upon this point in plaintiff's brief (pp. 29, 30) is labored, but not convincing. The question arises : suppose the trial of the case against Fry had not occurred at all ? Upon what, in the

nature of a judgment, could the Singer Company have had a writ of execution issued for the costs which were awarded to that company? Does any one suppose that a writ of execution could not be regularly issued on the judgment (p. 60 of the record) on behalf of the Singer Company, or that a levy under such a writ would be invalid because not supported by a judgment?

No Rebuttal Testimony Offered by Plaintiff.

The first point advanced by plaintiff's counsel in argument appears on page 8 of their brief, viz.: that the instruction to the jury to find a verdict for defendant precluded plaintiff from offering rebuttal evidence.

The obvious answer to counsel's proposition is that plaintiff did not offer any rebuttal testimony. If he had any rebuttal testimony he did not say so; he did not state what part of defendant's testimony he wished to rebut, nor did he produce any witness. We are not enlightened by plaintiff's brief as to what rebuttal testimony he had. Counsel is not rash enough to assert that the plaintiff did really have any rebuttal testimony to offer. The judgment roll from the Fry case (record, p. 55) was hardly susceptible of being rebutted. Judge McKenna's opinion in the Fry case certainly could not have been rebutted by testimony in this case. If the plaintiff really had rebuttal evidence to contradict Mr. Fry's testimony, it should have been offered. Mr. Fry's testimony was the only evidence on defendant's behalf

that could have been open to possible rebuttal. The substantial point in his testimony was that his connection with the former case was as the Singer Company's agent, merely, and not on his own behalf or his own responsibility; and this substantial point had been virtually alleged by the plaintiff himself in the second paragraph of his complaint in the former action (record, p. 56). However, who can say from the record that if the plaintiff had offered testimony of any kind in rebuttal of Mr. Fry's statements, it would have been rejected by the lower court? The first suggestion made by counsel regarding rebuttal testimony appears on page 86 of the record, where he says: "Counsel does not "know what rebuttal testimony we may have." This does not amount to the production of a witness nor to an offer of testimony, nor even to an offer to produce testimony. Among the reasons stated by plaintiff's counsel for his exception to the charge about to be made by the court to the jury, there appears the following language: "Lastly, the taking of the case away from the "jury at this time is preventing the plaintiff from putting "in any rebuttal testimony which he is ready and pre-"pared to put in" (record, pp. 87, 88). But this was not an offer of testimony. No witness was produced or called. No ruling of the court upon the subject of rebuttal testimony was invoked. Unquestionably, counsel should have called a witness in rebuttal if he had one. It can not be assumed that the court would have rejected rebuttal testimony if it had been offered. Error on the part of the court below is never *assumed.* Error must

affirmatively appear. All presumptions are in favor of the judgment, and of the regularity of the proceedings in the lower court.

> *Landers* vs. *Bolton*, 26 Cal., 396.
>
> *Nelson* vs. *Lemmon*, 10 Cal., 49.
>
> *People* vs. *Douglass*, 100 Cal., 1.
>
> *Doyle* vs. *Franklin*, 48 Cal., 537.

We are surprised to see in plaintiff's brief on page 8, third line from the bottom, a comma after the word "testimony." A similar punctuation mark also appears in line one, page 88 of the record. It is quite possible that the plaintiff's counsel thinks that the sense of the sentence is affected favorably for plaintiff by this punctuation mark. If there is any advantage to be gained by the plaintiff in a construction of the sentence with the comma, which advantage it could not have with the comma omitted, it would be an imposition upon the Court for plaintiff's counsel to attempt to gain such advantage. The comma referred to ought not to be in the record. It was *not* in the reporter's transcript of testimony, from which the bill of exceptions is supposed to have been prepared (reporter's transcript, p. 253). It was *not* in the draft of plaintiff's proposed bill of exceptions which was served upon defendant's counsel, as appears on page 17 of said draft. After proposed amendments to the bill of exceptions had been allowed by the Court, and an engrossed copy of the bill of exceptions was prepared at the office of plaintiff's counsel, this objection-

able comma was inserted in the engrossed copy of the bill of exceptions in *pencil mark, and appears there for the first time.* The attention of the plaintiff's counsel was immediately called to the improper insertion of this comma in the engrossed bill of exceptions, and it was thereupon stricken out. Owing to the fact that the clerk of the Circuit Court was supplied by plaintiff's attorney with a carbon copy of the engrossed bill of exceptions, from which copy this comma had not been stricken out, and which was certified by said clerk and sent to the clerk of this Court as correct, the transcript when printed was found to also contain the interpolated punctuation mark. Plaintiff's attorney was then asked to stipulate that it might be stricken out from the transcript of record by the clerk, but notwithstanding his knowledge of the facts above stated, the attorney declined to so stipulate, but did, however, stipulate that the mark might be "considered as stricken out from said transcript." The comma should be erased from the sentence in question, and it will then read as it was uttered by the attorney who spoke it, without any pause after the word "testimony." It does not appear from the counsel's language here referred to, and the language on page 86 of the record, that he really had any rebuttal testimony. "Counsel does not know what "rebuttal testimony we *may* have," he says (p. 86). The only way in which the suggestion of rebuttal testimony happened to get into the case was in connection with the technical attempt of plaintiff's counsel to compel the defendant to close its case absolutely, no matter what

the ruling of the Court might be (record, p. 86). It is clear from all the language of the Court that if plaintiff's counsel had offered any rebuttal testimony, it would have been admitted ; if a witness had been called, he would have been allowed to testify ; if, in a proper manner, such application had been made to the Court as it was the Court's right to have before a ruling could be asked for, the ruling would not have been adverse to the plaintiff.

Unless it appears that there was an offer of the testimony said to have been rejected, and such an offer as would enable the trial court to pass upon the relevancy of the testimony, there was no error.

> *Roberts* vs. *Unger*, 30 Cal., 676, 680.
> *Houghton* vs. *Clarke*, 80 Cal. 417, 420.

It is respectfully submitted that the judgment of the Circuit Court should be affirmed.

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